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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

SLA0376

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February 27, 2006

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Typed or printed name Scott C. Krieger

Application Number

09/932,661

Filed

08/17/2001

First Named Inventor

Andrew Ferlitsch

Art Unit

2624

Examiner

Kyle Pendergrass

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

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assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/98)

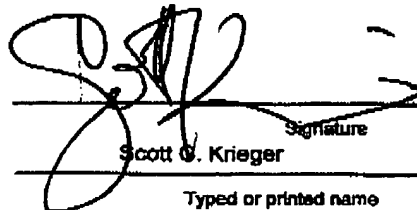
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attorney or agent of record.

Registration number 42,768☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____


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February 27, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

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FEB 27 2006

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT APPLICATION EXAMINING OPERATIONS**

Appl. No. : 09/932,661
Applicant : Andrew Ferlitsch
Filed : 08/17/2001
TC/A.U. : Art Unit 2624
Examiner : Kyle Pendergrass

Confirmation No. 4570

Docket No. : SLA 0376
Customer No. : 52894

Pre-Appeal Brief Request for Review

The examiner bases his rejection of the currently-claimed invention on Blossey et al. (U.S. Patent No. 6,057,930), hereafter referred to as Blossey et al., in view of the applicant's submitted prior art. This rejection of the currently-claimed invention is improper as it fails to present a prima facie case of obviousness.

The currently-claimed invention discloses methods and systems for providing collated, face-up finishing in printers that do not provide such a feature. As such, the currently-claimed invention teaches the **claimed element of manipulation of an index file** to effect the desired output from the printer not capable of producing, on its own, such output.

Blossey et al. teach, in column 5, lines 49-53, that the finishing requirements "which are present on the original job description data (such as on a separate job ticket or embedded in the file)" are carried out by the image output terminal. The examiner equates the job description data to the applicant's claimed page-independent index file. In the applicant's currently-claimed invention, the index file is manipulated to effect the desired output. However, Blossey et al. additionally state, in column 6, lines 11-16, that "these job description instructions submitted to image output terminal 170 will be manifest in specific instructions to the hardware of the image output terminal 170, such as obtaining paper of a particular type from one stack or another as the job is being printed." Blossey et al. do not disclose or teach a method for manipulating (also considered modifying or changing) the original job description data to a form of job description instructions that when submitted to the image output terminal will effect the finishing requirement as presented in the original job description data. The finishing requirements present

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in the job description data, as taught by Blossey et al., is submitted, lacking any manipulation, to the image output terminal and manifest by the output terminal in specific hardware instructions. As such, Blossey et. al. do not teach any type of manipulation of a print file that effects collated, face-up printing on a printer that does not individually have this feature. In fact, Blossey et al. have no motivation to manipulate the original job description data to effect a collated, face-up output orientation. The lack of motivation to manipulate the job description file is indicated where Blossey et al. specifically state, column 2 lines 56-59, "Further, several printing systems may exist on a network, and an individual client having a job to be printed will select a printing system capable of handing his or her particular job."

Blossey et al. teach a method for receiving scan jobs and print jobs and managing the order or priority in which the jobs are executed. Blossey et al. also teach spooling scan and print jobs and decomposition of PCL language jobs into a printer-ready format. However, Blossey et al. do not teach the use of a page-independent index file in any form. Nor do Blossey et al. teach manipulation of a print job in a manner that changes the end-product or output of the print job other than the order in which jobs are performed. Furthermore, Blossey et al. and the submitted prior art do not contain any teaching or motivation to combine the face up and collated output of the prior art with the teachings of Blossey et al. This is largely because the teachings of Blossey et al. cannot be combined with prior art to achieve any kind of face-up or collated printing as Blossey et al. do not disclose any way to manipulate the output of the print job.

Claims 1-16 have also been rejected under 35 U.S.C. §103(a) as being unpatentable over Barry et al. (U.S. Patent No. 6,825,943), hereafter referred to as Barry et al., in view of Young (U.S. Patent No. 5,749,024), hereafter referred to as Young, and applicant's submitted prior art. This rejection of claims 1-16 is also improper as it fails to present a prima facie case of obviousness.

Barry et al. disclose a method for splitting a print job into several portions for parallel RIP processing. In this process, Barry et al. disclose the use of a "control file" that contains parameters for managing the portions for parallel RIP processes. The control file is updated to keep track of the various portions while they are being apportioned. However, this control file is

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not analogous to the page-independent index file of these claims. Barry et al., or any combination of Barry et al. and Young or other prior art, do not disclose a page-independent index file that can be used to change the face-up or face-down characteristics of a print job. The control file of Barry et al. effects no face-up or face-down changes or any other change that affects the output of the print job.

The examiner cites Barry et al. (Fig. 1a; column 3, lines 15-19 and column 6, lines 9-13) as disclosing the page-independent index file. However, these references do not disclose anything related to the page-independent index file. Fig. 1a shows a block diagram disclosing a control file (110) that is created in the spooling process. Fig. 1a has no reference to a page-independent index file that can be used to effectuate face-up or face-down output. Barry et al., at column 3, lines 15-19, disclose that the control file is "for storing job control information" and that it "may be a storage location or it may be merely a temporary data file that travels with the print job." Column 3 has no reference to a page-independent index file that can be used to effectuate face-up or face-down output. Barry et al., at column 6, lines 9-13, disclose that the control file "contains operating parameters and program operators for controlling the operation of the processing of the print job file." Taken in context, this clearly relates to control of the multiple RIP processes. Again, there is no reference to a page-independent index file of any kind and, in particular, one that can be used to effectuate face-up or face-down output.

The examiner further cites Young and applicant's admitted prior art only as disclosing collation and face-up or face-down printing, which applicant admits are known in the art when accomplished by other methods that require special apparatus or dedicated drivers. Young and any admitted prior art do not disclose anything related to a page-independent index file nor do they teach any motivation to combine known methods with applicant's page-independent index file. In addition to not teaching any motivation for combination, Young, and any admitted prior art, and the control file of Barry et al. cannot be combined to effect the desired output of collated, face-up finishing. The references disclosing collation and face-up printing are known in the art only with respect to mechanical mechanisms or dedicated drivers, and the control file of Barry et al. cannot produce mechanical mechanisms or dedicated drivers.

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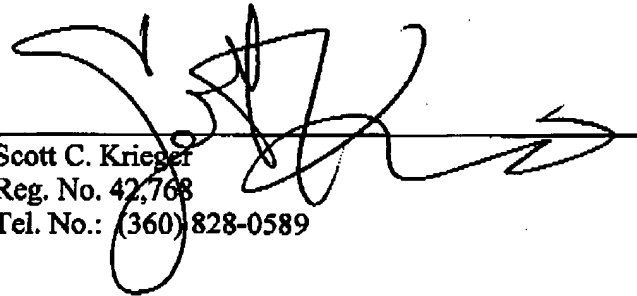
The examiner has rejected claim 17 under 35 U.S.C. §101 as being directed to non-statutory subject matter. This rejection is improper in that it fails to recognize the useful, concrete and tangible result of the claim. 35 U.S.C. §101 precludes abstract ideas from patentability. However, claim 17 claims a print job output in collated, face-up orientation, which are useful, concrete and tangible results of the claimed signal.

A practical application of an abstract idea is patentable if it produces a useful, concrete and tangible result. *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 47 USPQ2d 1596, 1601-02 (Fed. Cir 1998). The Federal Circuit has held similar software applications patentable when those applications did no more than manipulate numbers for a useful result. *AT&T Corp. V. Excel Comm. Inc.*, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999). In *AT&T*, the useful result was a modified long-distance telephone bill; in this application, the useful result is a print job output in collated, face-up orientation.

The USPTO has long endorsed this type of claim in their training guidelines for computer-related inventions, specifically the **Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, from October 26, 2005**. A computer data signal is typically regarded as equivalent to a computer readable medium, which is generally accepted as patentable subject matter when it comprises instructions that cause a computer to create a tangible result. A computer data signal is man-made, is considered functionally descriptive material, and is embodied in an "electronic transmission" that facilitates the functionality of the functionally descriptive material. Claim 17 should be allowed.

Based on the foregoing remarks, the Applicant respectfully requests reconsideration and allowance of the present application.

Respectfully submitted,



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